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PATS, JUSTIN

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE **3** MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2008*.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date *1-14-04*.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 8/14/08 has been entered, in which Applicant

amended claims 1 and 4 and added claims 7–12. Information Disclosure Statement filed 1/14/04,

has been considered.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions
> and requirements of this title.

3.   Claims 1–3 and 7–12 are directed to non-statutory subject matter because they fail to

meet the legal requirements of a 'process'. The first step in determining whether a claim recites

patent eligible subject matter is to determine whether the claim falls within one of the four

statutory categories of invention recited in 35 U.S.C. § 101: a process, machine, manufacture and

composition of matter. The latter three categories define "things" or "products," while a

"process" consists of a series of steps or acts to be performed. For the purposes of § 101, federal

case precedent has given a "process" a specialized, and limited meaning. *Diamond v. Diehr,* 450

U.S. 175, 184 (1981); *Parker* v. *Flook,* 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson,* 409

U.S. *63,* 70 (1972); *Cochrane* v. *Deener,* 94 U.S. 780,787-88 (1876). A § 101 process must

either (1) be tied to another statutory class (such as a particular apparatus) or (2) transform

underlying subject matter (such as an article or materials) to a different state or thing. If neither

of these requirements is met by the claim, the method is not a patent eligible process under §

101. Here, the claims merely apply, determine, select, and optimize data. These process steps

are not explicitly tied to another statutory class within the body of the claim (the word

automatically is insufficient, as well as the computer-implemented recitation in the preamble),

nor is there a transformation of the data pertinent to the claims. Thus, the methods of claims 1–3

and 7–12 are not patent eligible processes under § 101.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

5.   Claims 1–12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Desiraju et

al. (U.S. 6,243,613).

6.   As per claim 1, Desiraju et al. discloses a computer-implemented decision management

process comprising:

applying a decision management strategy for controlling behavior of clients of an

organization, the strategy being formed of components operating together (col. 6, lines 8-60; A

material planning system and decision management system help users to determine the optimum

strategies for suppliers; *see also* col. 1, lines 14–21, background of invention; and col., 3, lines

39–57, object of invention), wherein each component has a unique identifier and is associated

with one of an inbound event, outbound event, function, function set, segment, continuous

dimension, test group, and report group (*id.*, discussing the component corresponding to material

planning policies for suppliers, such as replenishment policies. Each component has a unique

identifier in that each materials policy has associated with it a particular Component Name and

Supplier. Also, the particular n-dimensional policy display and arrangement for each Component

Name and Supplier reflects a unique identification. Each component associates with an event that is both inbound in that the policies dictate how much component is delivered into the manufacturer, and outbound in that the manufacturer is outwardly dictating its component requirements to the supplier. Furthermore, Examiner notes that all of these types of components and their species are old and well known in the art of strategy management as evidenced by Applicant's admission within its drawings submitted 1/14/04—see Figs. 1–13, in which inbound events, outbound events, functions (including decision trees and score models and matrices), function sets, segments, continuous dimensions, test groups, and report groups are all admitted as prior art component types. It would have been obvious to one of ordinary skill in the art to modify Desiraju to include the teaching of Applicant via admitted prior art because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.);

determining results of the applied strategy (col. 7, lines 39-45; The data is used to determine a current material policy of a supplier.);

selecting, by the end user, respective components forming the strategy for optimization via the unique identifier for the respective component, potential replacement components for the selected component, and performance metrics for the potential replacement components and applying the selected potential replacement components, without applying the whole strategy, to prior performance data of the clients (col. 7, lines 55-62, Fig. 5, showing current and recommended replenishment policy identifiers; col. 8, lines 46-col. 9, line 11; Figures 7-8; A user can select components representing the current and recommended policies to review and

analyze the components and their effect. Here, the strategy regarding materials planning policies

is being applied only for one particular component name and supplier, not for the whole strategy

comprising the entire material planning policy operation, wherein the whole strategy pertains to

all of an organizations' components operating together);

determining results of the applied potential replacement components and automatically

optimizing the selected component forming the strategy, in accordance with the determined

results of the applied strategy, the determined results of the applied potential replacement

components, and the metrics, so that the strategy is altered to include the optimized component

(col. 10, lines 1-17; col. 11, lines 10-17; Results of the strategies are determined so as to exclude

or include certain options associated with the policies and select a final recommendation

strategy.).

Finally, the Examiner notes that although the components of Desiraju are not explicitly

one of the Markush group elements listed above, supplier material replenishment policies have a

strong association with inbound and outbound events as discussed above, as well as functions

and dimensions, given the manner in which Desiraju's policies are valued and displayed (*see*

discussion *supra*), thus at least suggesting the limitation. It would have been obvious to modify

Desiraju to include the types of components claimed above for the benefit of providing a more

detailed analysis of an organization's strategies, thus enabling the organization to make better

informed decisions and become more efficient and profitable in the long term.

7.   As per claim 2, Desiraju et al. discloses a computer-implemented decision management

process as in claim 1, wherein the selected performance metrics includes a threshold for the

potential replacement components, said automatically optimizing replacing the selected

component with a respective replacement component if performance improvement results of the

respective potential replacement component satisfy the threshold (col. 15, line 66-col. 16, line

25; Threshold values are used during assessing performance results.).

8.   As per claim 3, Desiraju et al. discloses a computer-implemented decision management

process as in claim 1, further comprising repeating the process of claim 1 for the applied strategy

(col. 15, lines 30-41; Components of strategies and strategies themselves can be reviewed and

analyzed by users at any time, thereby repeating the process for the applied strategy.).

9.   Claims 4-6 recite limitations similar to the limitations rejected above. Therefore, claims

4-6 are rejected on the same basis as claims 1-3 above.

10.   Claims 7–12 recite limitations that stand rejected via the art citations and rationale

applied to claim 1 as discussed above.

Response to Arguments

11.   Applicant's arguments filed 8/14/08 have been fully considered but they are not

persuasive.

12.   Applicant reiterates arguments provided in its previous amendment filed 11/30/07.

Applicant's Remarks, 8/14/08, pg. 7–8. These arguments have been refuted by Examiner in the

previous office action (*see* Final Rejection, 2/14/08).

13.   Applicant further argues that Desiraju does not disclose its newly added amendments,

namely selection via a unique identifier for the respective component, and application without

applying to the whole strategy. Applicant's Remarks, 8/14/08, pg. 8. In response, Desiraju

teaches these limitations as discussed in the rejection of claim 1 above (*see* discussion *supra* ¶ 6).

Conclusion

14.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

     A.   Teran et al., U.S. Patent No. 5,521,814.

Teran teaches at least the following: a computer-implemented decision management process comprising:

applying a decision management strategy, the strategy being formed of components operating together (see column 2, lines 29-36), the components being at least one of the group consisting of an attribute, and function, a function set, and segment, a test group, and a report group (8, lines 9-12, the independent variables represent components that are modifiable attributes of the system);

determining the results of the applied strategy (see column 8, lines 9-12, the dependent variables represent the results of the applied strategy);

selecting, by an end user of the process, a respective component forming the strategy for optimization (see column 8, lines 54-56, the control variable represents the selected component);

selecting, by the end user, potential replacement components and performance metrics for the potential replacement components (see column 8, lines 25-31);

applying the selected potential replacement components to prior performance data (see column 8, lines 31-33);

determining results of the applied potential replacement components (see column 8, lines 31-33);

automatically optimizing the selected component forming the strategy, without

optimizing the other components forming the strategy, in accordance with the determined results

of the applied strategy, the determined results of the applied potential replacement components,

and the metrics, to achieve goals of the organization (see column 8, lines 54-58, since the neural

networked must first be "trained" by applying "potential replacement components" to past

performance data, the selected variable is optimized in accordance with this data along with

previous results of the applied strategy to achieve" economic goals);

implementing the strategy with the optimized component in production (see column 4,

line 66 – column 5, line 6);

automatically implementing the strategy with the optimized component in production

(see column 4, line 66 – column 5, line 6);

providing the end user the ability to select whether the strategy with the optimized

component is to be implemented in production (see column 7, lines 48-51); and when the end

user selects that the strategy with the optimized component is to be implemented in production,

implementing the strategy with the optimized component in production (see column 7, lines 51-

53);

saving the selected performance metrics for use in a subsequent optimization of a

component of the strategy (see column 5, lines 24-32); and

saving the selected performance metrics; and performing a subsequent optimization of a

component of the strategy by automatically optimizing the component in accordance with the

saved performance metrics (see column 5, lines 24-32); and saving the results of said

automatically optimizing (see column 6, lines 11-16);

wherein said automatically optimizing automatically optimizes respective paths through the strategy (see figure 5, since the process optimizes selected independent variables, respective paths are also automatically optimized).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on Monday through Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/
Examiner, Art Unit 3623

/Andre Boyce/
Primary Examiner, Art Unit 3623